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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/734,290
Filing Date: December 11, 2000
Appellant(s): HOBBS, GEORGE BRADLEY

Scott A. Lund
For Appellant

EXAMINER'S ANSWER

This is in response to the Appeal Brief filed on November 01, 2006 appealing from the
Office action mailed on May 05, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The Examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6891635

Dutta

5-2005

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-26 and 29-34 are rejected under 35 USC 103(a) as being unpatentable over Dutta, USP 6, 891, 635B2.

As per claims 1-26 and 29-34, Dutta discloses a method of and a system for providing advertisements in web based printing over a communication network (communication link), such as the Internet. A remote printing web server receives advertisements from one or more advertisers (registering a plurality of advertisements from a plurality of advertisers). The advertisements may include target audience attributes, such as the profession of target audience members (advertisers' criteria). Digital advertising images and the target audience information are stored on the remote printing web server (storing the received advertisements in a database coupled to the print processing system). A print user (customer) connects to the remote printing web server, over the network, using a browser. Information about the user (user's profile), such as the user's occupation, is gathered in order to match the user with appropriate advertisements such that targeted advertisements can be presented or displayed to the user, over the network, when the print processing system or the web server processes a print job or print a request for printing submitted by the user. Advertisements are identified and combined with the document that the user wishes to print (presenting or displaying a customized advertisement in the user's document printed by the print processing system). The combined document is then printed on a printer connected to the remote printing web server. In addition, the document that the user

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wishes to print may be analyzed for document content in order to further select appropriate advertisements to include on the user's printouts or print jobs (presenting or displaying a customized advertisement in the user's document printed by the print processing system or printing web server based on the user's document content) or print job request).

(See abstract; col. 2: 5-32).

The present system deals with providing advertisements in web-based printing. More particularly, the present system deals with providing free or subsidized printing in exchange for advertising space on printed documents (col. 1: 9-14; col. 1: 15 to col. 2: 3).

Dutta discloses, in general, a system where advertisements can be placed on printouts requested by users of remote printers. Advertisers sign up to advertise to the general public or to particular groups of users. When a user is traveling and needs to print a document on a remote printer (i.e., a hotel, airport, copy service printer, etc.), he is asked for information about his occupation and other personal attributes of the user. This information is used to select advertising that is appropriate to the user. The user requests to print out electronic documents and the selected advertisements are included in the printout (col. 2: 5-39).

FIG. 1 is a network diagram showing the components used in remote web based printing with advertisements. Computer network 100, such as the Internet, is used to connect the various components to one another. Client device 110 such as a portable computer or other pervasive computing device is used as a user print client to connect to computer network 100. A program, such as browser 115 (i.e., Netscape Navigator.TM. Microsoft Explorer.TM., etc.) is used to communicate with other devices connected to computer network 100. **The user of client device**

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110 may wish to print a document stored on the client device, such as a word processing document or spreadsheet, or may wish to print a document stored on a third party server connected to computer network 110. When the user of client device 110 (customer's interface) wishes to print to remote printer 190, he or she interacts with software located on remote printing web server to send print request (print job) 120 through computer network 100 to remote printing web server 170 (print processing system). Remote printing web server 170 receives print request 150, inserts one or more advertisements into the printout and prints the electronic document and the included advertisements onto printer 190 (It is herein understood that the printing web server implicitly supports the step of creating or assigning a job number or ticket number to each print job or print request submitted by a user-col. 3: 3-23; col. 3: 23-59).

Advertisement insertion system 220 of fig. 2 includes four component functions. Advertisement repository puts and removes advertisements in a data storage area accessible by the remote printing web server. The repository also includes information about the intended audience for each advertisement stored in the repository. **Document content type determiner 230** is software for determining the type of document being printed based on keywords found in the document or other attributes of the document (i.e., website from which the document was downloaded, document titles, etc.). **Document content type determiner** also includes the type of file being printed, such as a spreadsheet, a word processing document, or a web page. **User type determiner software 235** determines the type of user that is printing a document (i.e., a doctor, an engineer, an accountant, etc.). This information can be gathered using interactive software that requests the information from the print user before a

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document is accepted for printing. Advertisement mapping table 240 is an electronic table including advertisement names (i.e., file names or other advertisement identifier) and the types of documents and users that are the target audience for the advertisement (presenting or displaying or inserting one or more targeted advertisements into the user's printed document when the printing web server processes the use's print request based on the user's profile (identification) and the type of document or file format being printed, quality of paper, printing of envelopes including other printing options). The advertising mapping table may also keep track of the number of times each advertisement has been included in a printout. (All ads displayed into the printed documents are registered ads col. 3: 60 to col. 4: 40).

Finally, FIG. 6 is a diagram showing the components involved in providing a printed document including registered advertisements. Advertisement insertion system table 600 (see FIG. 2 wherein the table was previously referred to as advertising matching table 240) includes user types (identified user), content types (document being printed) and advertising impressions suitable for the user type/content type. For example, when the user type (user's identification) is a "lawyer" and the document content type is a "spreadsheet" then advertisement #2 is appropriate. When the user type is a "doctor" and the document content type is a "spreadsheet" then advertisements #1 and #3 are appropriate. Finally, when the user type is a "doctor" and the document content type is a "word document" then advertisement #4 and #3 are appropriate. User client type 610 is received from the user's registration information from the user requesting to print. In the example shown, the client type is "doctor." Document type 620 is determined from the document sent for printing; in the example shown the document type is a spreadsheet (file

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type, file format). Advertisement insertion table 600 is used to determine that, for the example shown, advertisements #1 and #3 should be included with the printout. The advertisement images are retrieved from advertisement repository 630. Selected advertisements 640 are then inserted in the spreadsheet being printed, in this case a pharmacy ad from Advertiser X, and a medical equipment advertisement from Advertiser Z. The modified document (now including the advertising images), is then printed creating printed document 650. Advertisement insertion system table 600 also keeps track of the number of impressions left to be printed. In the example shown, **Ad #1 would be decremented from 224 impressions to 223 impressions and Ad #3 would be decremented from 193 impressions to 192 impressions left to be printed (col. 6: 14-45).**

As per claims 1, 11, 21, 24, 33 and 34, Dutta does not expressly disclose displaying the advertisement on the customer's interface (computer screen or display), while receiving or processing the print job, instead of printing the advertisement together with the customer's document.

However, it is common practice in the art to display an advertisement on a user's computer screen while the user's computer is dialing into an ISP system in order to connect to the Internet or during an idle time period as the user is waiting for a requested information or page to be retrieved or down loaded from a web server related to a web site in return for the privilege to receive free or discounted Internet service from the ISP (Internet Service Provider), which uses the revenues, collected from the advertisers to display their advertising content to the user(s), to

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subsidize the free or discounted service received by the user(s). Furthermore, it is well known in the art to display advertisements to a user's computer screen while the user is waiting for requested information to be retrieved or downloaded from a server related to an accessed web site. It is also customary in the art to allow a user accessing the Internet via an ISP to first read product information or advertising literature before the user is able to access the web for a limited free period of time, wherein revenues collected by the ISP from advertisers are used to subsidize the limited and free period of time provided to the user in return for reading or view product information displayed on his screen (no further disclosure is necessary here).

“Official Notice”

Thus, an ordinary skilled artisan would have been motivated at the time of the invention to incorporate the above disclosure (“Official Notice”) into the advertising distribution and printing system of Dutta so as to display a (targeted) advertisement on the screen of a computer's user upon receiving or while processing the user's print job instead of printing the advertisement along with the user's document associated with the print job especially if the printed document is addressed to a third party, such a prospective employer or recruiter, who should not receive or be exposed to the printed advertisement in the first place, thereby avoiding the embarrassment resulting from knowingly or accidentally printing an advertisement on top of a page of a document that is addressed to an important third party or VIP, such a prospective employer or a president of a hiring corporation, and efficiently using processing idle time by outputting the advertisement on the user's computer screen, while saving papers, ink and reducing processing time and, hence saving money, by not having to print the advertisement along with the document and while protecting the environment by using less papers and thus, cutting fewer trees, by

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displaying the advertisement on the user's computer screen (customer's interface) as the user is waiting for the print job or the document to be printed or executed especially if the print queue contains other previously submitted print jobs that should be processed before the user's print job.

(10) Response to Argument

In general, regarding independent claims 1, 11 and 21, Appellant argues that the combination of the prior art **does not yield to displaying advertisement on the customer's interface** (see page 6 and second paragraph of the Brief) and that the Dutta's Patent (primary reference) actually teaches away from displaying advertisements. Here, the Appellant advances that Dutta (the primary reference) recognizes that Internet advertisements, such as banners, only appear for a short period of time on a user's screen or interface and disappears when the user switches to a different screen or visits another web page or web site. Thus, continues the Appellant, modifying the Dutta's Patent in the manner suggested by the Examiner to display the advertisements instead of printing the advertisements would simply return the system and method of Dutta's Patent to the unsatisfactory arrangement of the stated prior art problem (see pages 8 and 9 of the Brief). The Examiner completely and respectfully disagrees with the Appellant's findings:

First, Dutta discloses a method of and a system for providing advertisements in web based printing over a communication network (communication link), such as the Internet. A remote printing web server receives advertisements from one or more advertisers (registering a plurality of advertisements from a plurality of advertisers). The advertisements may include

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target audience attributes, such as the profession of target audience members (advertisers' criteria). Digital advertising images and the target audience information are stored on the remote printing web server (storing the received advertisements in a database coupled to the print processing system). A print user (customer) connects to the remote printing web server, over the network, using a browser. Information about the user (user's profile), such as the user's occupation, is gathered in order to match the user with appropriate advertisements such that targeted advertisements can be presented or displayed to the user, over the network, when the print processing system or the web server processes a print job or print a request for printing submitted by the user. Advertisements are identified and combined with the document that the user wishes to print (presenting or displaying a customized advertisement in the user's document printed by the print processing system). The combined document is then printed on a printer connected to the remote printing web server. In addition, the document that the user wishes to print may be analyzed for document content in order to further select appropriate advertisements to include on the user's printouts or print jobs (presenting or displaying a customized advertisement in the user's document printed by the print processing system or printing web server based on the user's document content) or print job request).

(See abstract; col. 2: 5-32).

Second, Dutta (as per claims 1, 11, 21, 24, 33 and 34), does not expressly disclose displaying the advertisement on the customer's interface (computer screen or display), while receiving or processing the print job, instead of printing the advertisement together with the customer's document.

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However, it is common practice in the art to display an advertisement on a user's computer screen while the user's computer is dialing into an ISP system in order to connect to the Internet or during an idle time period as the user is waiting for a requested information or page to be retrieved or down loaded from a web server related to a web site in return for the privilege to receive free or discounted Internet service from the ISP (Internet Service Provider), which uses the revenues, collected from the advertisers to display their advertising content to the user(s), to subsidize the free or discounted service received by the user(s). Furthermore, it is well known in the art to display advertisements to a user's computer screen while the user is waiting for requested information to be retrieved or downloaded from a server related to an accessed web site. It is also customary in the art to allow a user accessing the Internet via an ISP to first read product information or advertising literature before the user is able to access the web for a limited free period of time, wherein revenues collected by the ISP from advertisers are used to subsidize the limited and free period of time provided to the user in return for reading or view product information displayed on his screen (no further disclosure is necessary here).

"Official Notice"

Thus, an ordinary skilled artisan would have been motivated at the time of the invention to incorporate the above disclosure ("Official Notice") into the advertising distribution and printing system of Dutta so as to display a (targeted) advertisement on the screen of a computer's user upon receiving or while processing the user's print job instead of printing the advertisement along with the user's document associated with the print job especially if the printed document is addressed to a third party, such a prospective employer or recruiter, who should not receive or be exposed to the printed advertisement in the first place, thereby avoiding the embarrassment

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resulting from knowingly or accidentally printing an advertisement on top of a page of a document that is addressed to an important third party or VIP, such a prospective employer or a president of a hiring corporation, and efficiently using processing idle time by outputting the advertisement on the user's computer screen, while saving papers, ink and reducing processing time and, hence saving money, by not having to print the advertisement along with the document and while protecting the environment by using less papers and thus, cutting fewer trees, by displaying the advertisement on the user's computer screen (customer's interface) as the user is waiting for the print job or the document to be printed or executed especially if the print queue contains other previously submitted print jobs that should be processed before the user's print job.

As described above, and contrary to the Appellant's contention, the user in the Dutta's system is patiently waiting for his print job to be completed and is not browsing or switching from one page to another or visiting a new web site. The waiting period creates an idle time or time delay, which provides an excellent opportunity for displaying a message or an ad to the user on the user's interface or computer screen during the waiting period or period of non-activity while the user is patiently waiting for his print job to be completed, as an ordinary skilled artisan would have concluded at the time of the invention. The waiting period, the delay or the idle time, during which a message or an ad is displayed on the user's computer screen, varies from print job to print job and it is also based on whether the print job or the document being printed is a text or an image or a combination thereof. And the delay period or the idle time may be greater than, for instance, 60 seconds depending on the number of pages being printed or whether or not the print job includes images or graphics.

Moreover, contrary to the Appellant's remarks, Dutta does not teach away from displaying advertisements. Indeed, in column 1: lines 51-67, Dutta simply states that current web-based advertisements are ineffective since they only appear for a brief time to a user while the user changes screens or visits another web page and the user may forget the information displayed thereon. Dutta further admits, as shown in col. 2: 1-3, that a need arises in the industry to find a way to merge advertisers' objectives of identifying and targeting groups of users with users' need for printing documents while traveling. Dutta, contrary to the Appellant's findings, never discloses a system for preventing the display of web-based advertisements and thus, Dutta does not teach from displaying advertisements.

Therefore, an ordinary skilled artisan implementing the system of Dutta and being aware of the fact that it is customary in the art to display a message or an ad on a user's screen during an idle time, would have realized that a delay or an idle period exists during the time a user requests a print job and the time the print job is being completed and would have been motivated, at the time of the invention, to take advantage of the idle period or delay to display one or more targeted advertisements to the user via an interface or computer screen of the user, **thereby avoiding, among other things, the embarrassment resulting from knowingly or accidentally printing an advertisement on top of a page of a user's document that is being addressed to an important third party or VIP, such a prospective employer or a president of a hiring corporation, and efficiently using processing idle time by outputting the advertisement(s) on the user's computer screen or customer's interface, while saving papers, ink and reducing processing time and, hence saving money, by not having to print the advertisement along with the document and while protecting the environment by using less**

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papers and thus, cutting fewer trees, by displaying the advertisement on the user's computer screen (customer's interface) as the user is waiting for the print job or the document to be printed or executed especially if the print queue contains other previously submitted print jobs that should be processed before the user's print job or the user's print job contains one or more images or graphics, which usually take more time to print (as known in the art).

The above conclusion **or the motivation to combine** the Dutta's Patent with the well known materials featured in the "Office Notice" is well within the level of skills or knowledge of an ordinary artisan. Further, contrary to the Appellant's conclusion, **modifying** the Dutta's Patent, as suggested here, does not render the Dutta's system unsatisfactory or inoperable since the system will continue to process and execute a requested print job in the same manner except that the associated advertisements are being re-routed and displayed on the user's interface instead of printing them onto the user's printed documents. Here, no new computer hardware is required to implement such a modification, which calls for updating or altering the software or computer codes in the Dutta's system to re-route and display the desired ads on the user's interface during the delay period instead of inserting them into the user's printed document(s), as one skilled in the area of computer programming would have concluded at the time of the invention.

Additionally, as seen above, the combination does yield to a reasonable expectation of success since the chance that the user will pay attention to the ads, displayed on the user's interface during the period of non-activity while the user is patiently waiting for his print job to be completed, significantly increases.

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In short, what was at stake here was whether a person of ordinary skill in the art would have had sufficient motivation to incorporate the well known display method of ads on a user's interface into the printing system of system of Dutta's to thereby arrive at the claimed invention as recited in at least the independent claims. The foregoing response has indeed answered that question.

Finally, the Appellant's request for allowance or withdrawal of the last Office Action has been fully considered and respectfully denied in view of the foregoing response since the Appellant's arguments as herein presented are not plausible and thus, the rejections should be sustained.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

JDJ

01/17/07

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